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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,738	02/12/2001	Karen L. Capers	01 P 7465 US	9666
7590	12/16/2004			
Elsa Keller Siemens Corporation 186 Wood Avenue South Iselin, NJ 08830			EXAMINER PHILLIPS, HASSAN A	
			ART UNIT	PAPER NUMBER
			2151	

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/782,738	CAPERS ET AL.	
	Examiner	Art Unit	
	Hassan Phillips	2151	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is in response to amendments received on August 19, 2004.

Specification

1. The Examiner has received the amendments made to the Specification. After consideration of the amendments, the Examiner has withdrawn the objection to the Specification.

Response to Arguments

1. Applicant's arguments filed August 19, 2004 have been fully considered but they are not persuasive. See page 10, 2nd paragraph.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, motivation to combine Halahmi with the teachings of Hawkins is found in col. 6, lines 12-17. In this passage Halahmi shows an efficient means for transmitting and displaying the contents

Art Unit: 2151

of unsolicited messages, wherein, unsolicited messages are converted to formats most suitable for presentation on wireless devices. Motivation is further found in Halahmi, col. 4, lines 24-60, where it is stated that the teachings of Halahmi are operative with **any** type of protocol used with unsolicited messages.

2. Applicant's arguments with respect to claims 1-21 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-21, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins, U.S. patent publication 2001/0032254, in view of Halahmi, U.S. patent 6,684,088.

3. In considering claims 1 and 9, Hawkins discloses a method for providing data applications for a mobile device 100, through an integrated communication server 180, of a private network 172, comprising:

- a) Receiving unsolicited messages in an external format from an external data source for the mobile device, (page 11, paragraph 161);
- b) Converting the unsolicited messages from the external format to an internal format and providing the unsolicited messages in the internal format to the mobile device, (page 5, paragraph 85).

Although the disclosed method of Hawkins shows substantial features of the claimed invention, it fails to expressly disclose:

- a) The message format being a data format.

Nevertheless, in a similar field of endeavor Halahmi discloses a system and method for transmitting e-mail messages to mobile devices comprising:

- a) Converting unsolicited messages from external data formats to internal data formats, (col. 6, lines 10-17).

Given the teachings of Halahmi, it would have been obvious to one of ordinary skill in the art to modify the teachings of Hawkins to have an external data format defining a structure of data in the unsolicited message, and to convert the unsolicited message from the external data format to an internal data format. This would have contributed to a significant improvement in providing an efficient means for transmitting and displaying the contents of unsolicited messages, wherein, unsolicited messages would be converted to data formats most suitable for presentation on wireless devices, Halahmi, col. 6, lines 12-17.

9. In considering claims 2, 4, 6, 8, 10, and 12, Halahmi discloses a system and method for transmitting e-mail messages to mobile devices comprising: converting an unsolicited message to an internal data format of a mobile device, the internal data format comprising XML, (col. 6, lines 10-17). One of ordinary skill in the art would modify the teachings of Hawkins with Halahmi for the same reasons indicated in consideration of claims 1, 5, and 9.

10. In considering claims 3 and 11, the method of Hawkins comprises a means for receiving a response message in the internal data format from the mobile device for the external data source, the response message based on the unsolicited message, (page 11, paragraph 161); and converting the response message from the internal data format to the external data format and providing the response message in the external data format to the external data source, (page 5, paragraph 85).

11. In considering claim 5, Hawkins discloses a method for providing data applications for a mobile device through an integrated communication server of a private network, comprising:

- a) Receiving a request message 124, in an internal format from the mobile device for an external data source, converting the request message from the internal format to an external format, and providing the request message in the external format 126, to the external data source 140, (page 6, paragraph 93, also see Fig. 1).

Although the disclosed method of Hawkins shows substantial features of the claimed invention, it fails to expressly disclose:

- b) The message format being a data format.

Nevertheless, in a similar field of endeavor Halahmi discloses a system and method for transmitting e-mail messages to mobile devices comprising:

- b) Converting unsolicited messages from external data formats to internal data formats, (col. 6, lines 10-17).

Given the teachings of Halahmi, it would have been obvious to one of ordinary skill in the art to modify the teachings of Hawkins to have an external data format defining a structure of data in the unsolicited message, and to convert the unsolicited message from the external data format to an internal data format. This would have contributed to a significant improvement in providing an efficient means for transmitting and displaying the contents of unsolicited messages, wherein, unsolicited messages would be converted to data formats most suitable for presentation on wireless devices, Halahmi, col. 6, lines 12-17.

9. In considering claim 7, Hawkins further comprises a means for receiving a response message 136 in an external data format from the external data source for the mobile device, the response message based on the request message, converting the response message from the external data format to the internal data format, and providing the response message in the internal data format 132 to the mobile device, (page 6, paragraph 93, also see Fig. 1).

10. In considering claim 13, Hawkins discloses:

- a) An integrated communication server 180, of a private network 172, operable to provide data applications for a mobile device 100, the server operable to convert incoming data in one of a plurality of external formats into incoming data in an internal format, (page 5, paragraph 85).

Although the disclosed method of Hawkins shows substantial features of the claimed invention, it fails to expressly disclose:

- c) The format being a data format.

Nevertheless, in a similar field of endeavor Halahmi discloses a system and method for transmitting e-mail messages to mobile devices comprising:

- c) Converting unsolicited messages from external data formats to internal data formats, (col. 6, lines 10-17).

Given the teachings of Halahmi, it would have been obvious to one of ordinary skill in the art to modify the teachings of Hawkins to have an external data format defining a structure of data in the unsolicited message, and to convert the unsolicited message from the external data format to an internal data format. This would have contributed to a significant improvement in providing an efficient means for transmitting and displaying the contents of unsolicited messages, wherein, unsolicited messages would be converted to data formats most suitable for presentation on wireless devices, Halahmi, col. 6, lines 12-17.

9. In considering claim 14, Hawkins further provides a means for receiving the incoming data in the external data format from an external data source, the external data format for the incoming data based on the external data source, (page 6, paragraph 93).

10. In considering claim 15, Hawkins further provides a means for sending the incoming data in the internal data format to the mobile device, (page 6, paragraph 93).

11. In considering claim 16, Hawkins further provides a means for converting outgoing data in the internal data format into outgoing data in one of the external data formats, the external data format for the outgoing data based on a corresponding external data source operable to receive the outgoing data, (page 6, paragraph 93).

12. In considering claim 17, Hawkins further provides a means for receiving the outgoing data in the internal data format from the mobile device, (page 6, paragraph 93).

13. In considering claim 18, Hawkins further provides a means for sending the outgoing data in the external format to the corresponding external data source, (page 6, paragraph 93).

14. In considering claim 19, Hawkins further provides a means for implementing an abstraction for each of the external data formats, (page 5, paragraph 85).

15. In considering claim 20, it is implicit in the teachings disclosed by Hawkins that the server 180 provides an interface for each of a plurality of external data sources, each external data source corresponding to one of the external data formats, each of the interfaces decoupled from the abstraction of the corresponding external data format, (page 5, paragraph 85, also see Fig. 1).

16. In considering claim 21, Hawkins discloses a method for providing data applications for a mobile device through an integrated communication server of a private network, comprising:

- a) Receiving unsolicited messages in an external format from an external data source for the mobile device, (page 6, paragraph 95);
- b) Converting the unsolicited messages from the external format to an internal format and providing the unsolicited messages in the internal format to the mobile device, (page 5, paragraph 85);
- c) Receiving a response message in the internal format from the mobile device for the external data source, the response message based on the unsolicited message, (page 11, paragraph 161);

- d) Converting the response message from the internal format to the external format and providing the response message in the external format to the external data source, (page 5, paragraph 85);
- e) Receiving a request message, in an internal format from the mobile device for an external data source, converting the request message from the internal format to an external format, and providing the request message in the external format, to the external data source, (page 6, paragraph 93, also see Fig. 1);
- f) Receiving a response message in the external format from the external data source for the mobile device, the response message based on the request message, converting the response message from the external format to the internal format, and providing the response message in the internal format to the mobile device, (page 6, paragraph 93, also see Fig. 1).

Although the disclosed method of Hawkins shows substantial features of the claimed invention, it fails to expressly disclose:

- d) The format being an XML data format.

Nevertheless, in a similar field of endeavor Halahmi discloses a system and method for transmitting e-mail messages to mobile devices comprising:

- d) Converting unsolicited messages from external data formats to internal XML data formats, (col. 6, lines 10-17).

Art Unit: 2151

Given the teachings of Halahmi, it would have been obvious to one of ordinary skill in the art to modify the teachings of Hawkins to have an external data format defining a structure of data in the unsolicited message, and to convert the unsolicited message from the external data format to an internal data format. This would have contributed to a significant improvement in providing an efficient means for transmitting and displaying the contents of unsolicited messages, wherein, unsolicited messages would be converted to data formats most suitable for presentation on wireless devices, Halahmi, col. 6, lines 12-17.

Conclusion

1. The Examiner has interpreted the claim language as broadly as possible. It is also the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in a manner that distinguishes over the prior art.

Failure for Applicant to significantly narrow definition/scope of the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response and reiterated the need for Applicant to define the claimed invention more clearly and distinctly. Applicant is requested to review the prior art of record for further consideration

2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hassan Phillips whose telephone number is (571) 272-3940. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (571) 272-3939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2151

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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12/9/04



ZARNI MAUNG
PRIMARY EXAMINER